IV. REMARKS

1.   Claims 1, 2, 5, 6, 15, 18, 19, 20, 21 and 26 are amended. Claims 30-50 are new.   The Abstract is amended.

2.   Claims 1-10, 12-15, 17-24 and 27-29 are not unpatentable over Miller et al. ("Miller") in view of Proust et al. ("Proust") under 35 U.S.C. §103(a).

Claim 1 recites that the filtering parameter classifies a type of the electronic information and that the terminal automatically allows or prevents the delivery of the electronic information on the basis of the filtering parameter.   This is not disclosed or suggested by Miller in view of Proust.   In Miller, notifications of email are made according to a user profile, which primarily involves delivery options for the notification. (See e.g. Fig. 4(c).   Unlike Applicant's invention, the user profile does not make a determination or decision based on a classification type of the electronic information.   In Miller, the user then must manually interpret the notification and elect, by pressing one or more buttons, whether to receive the email and attachments.   In Applicant's invention, the terminal checks the filtering parameter, based on the classification type, determines whether the electronic information is received or rejected.

Miller is unlike Applicant's invention.   Upon receipt of a message, the network determines an appropriate action to take with respect to the message based upon a "profile of the subscriber."   (Abstract,   lines   7-10).   The   input filtering/forwarding subsystem 110, consults a "user profile database" to determine how to process an input.   (Col. 2, line 65

to Col. 3, line 2). The user profile comprises rules that determine how/when messages are to be treated. (Col. 4, lines 48-51). What these filtering rules define is where a notification will be sent, as illustrated by the "permanent rule" and the "vacation rule." (Col. 4, lines 51-61). The rule setup for Miller is shown in FIG. 4c and is time, date and sender specific. (Col. 5, lines 1-6; FIG. 4c). Thus, in Miller an incoming notification is "routed" based on the input filtering rules, to the appropriate location. (Col. 5, lines 11-13). The email and type is then displayed to the user. (Col. 5, lines 15-17; FIG. 4e).

The user must press keys to view "content" of the email. (Col. 5, lines 34-40). If the user desires the email based on what he has reviewed, the user can select retrieval. (Col. 5, lines 42-59). Thus, while Miller may involve a certain amount of "filtering", the filtering process is unlike Applicant's invention.

In Applicant's invention, filter parameters are associated with the electronic information based on the class of the message, i.e., its type, and not its format. It is the actual content class that is determinative, not the presentation format. Applicant's invention associates type descriptive filtering parameters, which are not disclosed or suggested by Miller. In Applicant's invention, it is the terminal that perceives the meaning of such parameters and prevents or retrieves messages. In Miller, the user manually determines desirable content. Thus, Miller does not disclose or suggest the features of Applicant's invention.

Proust does not overcome these deficiencies. Proust is merely the structure of a short message. A checksum calculation

22

verifies the integrity of the message. The combination of Miller and Proust does not achieve a filtering system based on a classification parameter that automatically determines whether to accept or reject the electronic information. Thus, claim 1 is not disclosed or suggested.

Since neither Miller nor Proust disclose or suggest each feature of Applicant's invention, claims 1, 15, 18 and 20 should be allowable, as well as each claim that depends therefrom.

Furthermore, it is submitted that there is no motivation to combine Miller with Proust to achieve Applicant's invention, as is required for obviousness under 35 U.S.C. §103(a). In order to establish a *prima facie* case of obviousness under 35 U.S.C. §103(a), there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or combine reference teachings. There must also be a reasonable expectation of success, and the reference(s), when combined, must teach or suggest all of the claim limitations. (See M.P.E.P. §2142). As noted above, the combination of Miller and Proust does not disclose or suggest each feature of Applicant's invention as claimed.

Neither reference provides the requisite suggestion or motivation to modify the references as proposed by the Examiner. The Examiner's proposition that Applicants' invention would be obvious as recited in the claims is not supported by the factual contents of Miller and Proust.

Miller deals with acting on a message received based upon a profile of the subscriber and then giving the user the opportunity to accept or reject the message. Proust deals with

the structure of an enhanced short message. Nothing in Proust pertains to a terminal taking action with respect to an enhanced message based upon a profile of the subscriber that defines a message by a classification parameter or type. A person of skill in the art would not make the reach from Miller to Proust without hindsight knowledge of Applicant's invention.

Thus, the references themselves and/or the knowledge generally available to one of skill in the art does not provide the requisite motivation or suggestion to modify the references as proposed for purposes of 35 U.S.C. §103(a). When "the PTO asserts that there is an explicit or implicit teaching or suggestion in the prior art, it must indicate where such a teaching or suggestion appears in the reference". In re Rijckaert, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). The Examiner is requested to provide an indication as to where any such teaching, suggestion or motivation appears in the references. Absent such a teaching, it is submitted that a *prima facie* case of obviousness over Miller and Proust under 35 U.S.C. §103(a) is not established.

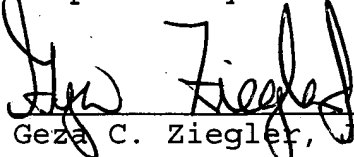Thus, claims 1-10, 12-15, 17-24 and 27-29 should be allowable.

3. Applicant appreciates the Examiner's indication of allowable subject matter. Claims 11, 16, 25 and 26 have been rewritten as claims 30, 36 and 38.

For all of the foregoing reasons, it is respectfully submitted that all of the claims now present in the application are clearly novel and patentable over the prior art of record, and are in proper form for allowance. Accordingly, favorable reconsideration and allowance is respectfully requested. Should

24

any unresolved issues remain, the Examiner is invited to call Applicants' attorney at the telephone number indicated below.

A check in the amount of $808 is enclosed for additional claim fees. The Commissioner is hereby authorized to charge payment for any fees associated with this communication or credit any over payment to Deposit Account No. 16-1350.

Respectfully submitted,

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